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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,519	11/09/2000	Satoru Nippa	2185-480P	1737
2292 7590 08/27/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER
			NOTIFICATION DATE 08/27/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

09/708,519

Applicant(s)

NIPPA, SATORU

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/31/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Information Disclosure Statement**

1. The IDS filed 1/30/07 has been considered. It is noted that Nippa et al. (U.S. 6,130,283) has been stricken from the IDS as redundant given that it was already cited on the PTO-892 mailed 1/31/02.

**Claim Rejections - 35 USC § 102**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. (U.S. 4,491,553).

The rejection is adequately set forth in paragraph 5 of the office action mailed 12/13/06 and is incorporated here by reference.

**Response to Arguments**

4. Applicant's arguments and 1.132 declaration filed 6/12/07 have been fully considered but they are not persuasive.

In the office action mailed 12/13/06, the examiner stated that the 1.132 declaration filed 9/21/06 was not persuasive for several reasons as set forth on pages 4-6 of the office action mailed 12/13/06.

In response, applicant filed new declaration on 6/12/07. It is noted that all the examiner's arguments with respect to the previous declaration have been addressed with one exception. For this reason, it is the examiner's position that the declaration is not persuasive.

Specifically, as set forth on page 6 of the office action mailed 12/13/06, it is the examiner's position the declaration is not persuasive given that there is no disclosure regarding the significance of the results found in the declaration. It is noted that the resin composite of the example in the declaration possesses Y/X index of 0.138 while the present claims require resin composite with Y/X index of 0.1 or less. Thus, it is not clear how significant the difference is between the Y/X index for the presently claimed resin composite and that disclosed by Yamada et al. As set forth in MPEP 716.02(b), the burden is on applicant to establish that the results are unexpected and significant. The evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance", *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992).

The above is especially significant given that, as calculated in the 1.132 declaration, the resin composite of Yamada et al. possesses Y/X of 0.138. When rounded to one significant figure (commensurate with the significant figures of the value of Y/X presently claimed), Y/X as calculated from Yamada et al. is 0.1, which is identical to presently claimed Y/X.

In response to the examiner's point of the significance of the results, applicant argues that the tensile strength of experiment 2 of the declaration is 4.1 MPa, which is much lower than the 6.8 MPa of example 1 of the present specification.

However, although there is a difference in tensile strength between the resin composite of inventive example 1 of the present invention and the resin composite of example 2 as set forth in

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the 1.132 declaration that corresponds to Yamada et al., such difference does not establish that the results are significant given that Y/X of example 1 is only 0.038. This is much lower than Y/X of example 2. There is no data at the upper end of the presently claimed range of Y/X, i.e. at Y/X of 0.1. Would the tensile strength be as different when Y/X is 0.1 instead of 0.038? This is significant given that it is the examiner's position that given the small difference between Y/X of Yamada et al. and Y/X as presently claimed, it is not clear if such difference is significant. While example 1 shows tensile strength for Y/X of 0.038, this does not establish whether the difference between Y/X of 0.138 and Y/X of 0.1 as presently claimed is significant.

Further, given differences between example 1 and of the present specification and example 2 of the declaration, i.e. different types and amounts of aluminum hydroxide, styrene-butadiene, zinc oxide, vulcanizing accelerator, etc., it is not clear if the difference in tensile strength of the resin composite of the present invention and that of Yamada et al. is due to the difference in Y/X or due to these other differences.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

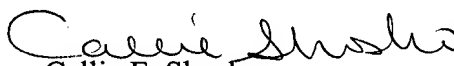
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Callie E. Shosho  
Primary Examiner  
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CS  
8/20/07